

REMARKS

I. Claim Objections

In the Final Office Action dated June 24, 2009, the Examiner objected to claims 1, 10 and 20 under 35 U.S.C. §132(a) arguing that the claims introduce new matter into the disclosure. The Examiner asserted that the new matter introduced into the disclosure is as follows: "comprises detailed information about said at least one digital image only" (Claims 1, 10 and 20).

The Applicant notes that the Examiner appears to be confusing U.S.C. §132 with §112, first paragraph. MPEP §08.04 states that new matter entered in the *claims* is to be rejected under 35 U.S.C. §112, first paragraph while new matter entered in the *specification* is to be objected to under U.S.C. §132.

The Applicant will therefore treat the Examiner's objections under §132 as *rejections* under §112, first paragraph. The Applicant further notes that claims 1, 10 and 20 have been cancelled with this amendment, thereby rendering moot the Examiner's arguments against these claims.

II. Claim Rejections - 35 USC § 103

Requirements for *Prima Facie* Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of *all* the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Komar in view of Kitsukawa and Ma

The Examiner rejected Claims 1-10 and 12-20 under 35 U.S.C. §103(a) as being unpatentable over Komar et al. (U.S. Patent Publication No. 2003/0079224), hereinafter referred to as "Komar", in view of Kitsukawa et al. (U.S. Patent No. 6,282,713), hereinafter referred to as "Kitsukawa" and further in view of Ma et al. (U.S. Patent No. 6,282,713), hereinafter referred to as "Ma".

Regarding claims 1 and 10, the Examiner argued that Komar discloses a method and system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item comprising a

digital image (citing Komar page 3, paragraph [0024]) (The Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved. The Examiner argued that this discloses the capability to store images and search for an image since databases includes operations like searching. The Examiner argued therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images.); associating at least one object with a data item of said at least one data item, wherein said at least one object contains information relevant to said data item and wherein said at least one object comprises an iconette (citing Komar page 2, paragraphs [0020]-[0021] and page 4, paragraph [0031]); and further wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing Komar page 2, paragraph [0019]; and page 4, paragraph [0023]) (The Examiner argued that here in addition to being able to provide information about the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner further argued that disclosed in Komar is the *functionality* to display both sources of information and one or the other as deemed for the selected area.); and displaying said data item in allocation of a display screen proximate to said at least one object, and wherein a selection of said at least one object invokes a display of said information relevant to said data item, wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing Komar page 2, paragraph [0016] and page 3, paragraph [0025]).

However, the Examiner admitted that Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. However the Examiner argued that Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing Kitsukawa FIG. 5 and col. 8, lines 57-67). Therefore, the Examiner argued that it would have been obvious to one

having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view to show detailed images of possible selections such as unobstructed view with focus set on item only.

The Examiner further admitted that Komar does not disclose a *user* searches through the database. However, the Examiner argued that Ma has disclosed an image database that allows a user to search for a particular image (citing Ma abstract). The Examiner argued that therefore it would have been obvious to make the database on Komar a user searchable database as taught by Ma. The Examiner argued that one would have been motivated to allow the user to search the database because it would provide a direct and efficient query for known items of interest to the user.

Regarding claims 5 and 15, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses information relevant to said data item in a form of graphical pop-up window, which when selected by user activates an additional graphical window comprising further information relevant to said data item as in claims 4 and 14 above and further discloses that the additional graphical window comprises an interactive region for initiating at least one user transaction thereof (citing Komar, page 2, paragraph [0016]).

Regarding claim 6 and 16, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses at least one object as a graphical iconette displayable on said display screen (citing Komar, page 2, paragraph [0016]; page 4, paragraph [0004] and page 31).

Regarding claims 7 and 17, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses that the item comprises a graphical image (Komar, page 2, paragraph [0017]; page 3, paragraph [0026]).

Regarding claims 8 and 18, the Examiner argued that Komar and Kitsukawa disclose a method and system as in claims 1 and 10 above and further discloses displaying a compacted view of a plurality of data items in a display area of a display screen, wherein at least one data item among said plurality of data items is displayed proximate to at least one object containing information relevant to said at least one data item, wherein a selection of said at least one object invokes a display of information relevant to said at least one data item (citing Komar, page 2, paragraph [0016]; page 23, paragraph [0023]; and page 4, paragraph [0031]).

Regarding claim 9, the Examiner argued that Komar and Kitsukawa disclose a method as in claim 1 above and further discloses: a) displaying data associated with said data item as a graphical icon on said display screen (citing Komar, page 2, paragraphs [0016] and [0020]); and b) displaying said at least one object as a graphical iconette embedded within a graphical frame surrounding said graphical icon, wherein said graphical iconette can be invoked by said user to display information relevant to said graphical icon (citing Komar, page 4, paragraph [0031]).

The Applicant notes that claims 1-10 and 12-20 have been cancelled with this amendment rendering moot the Examiner's arguments against these claims.

Komar in view of Kitsukawa, Ma, Willner and Davis

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa and Ma as applied in claim 10, and further in view of Willner et al. (U.S. Patent No. 7,149,370), hereinafter referred to as "Willner" and Davis et al. (U.S. Patent No. 7, 010,370), hereinafter referred to as "Davis".

Regarding claim 13, the Examiner argued that Komar, Kitsukawa and Ma disclose a method and system as in claim 10 above and further discloses selecting said at least one object to invoke a display of information relevant to said data item (citing Komar, page 2, paragraph [0016]). The Examiner admitted that the

combination does not explicitly disclose wherein said object of information includes at least one of the following; copyrights, tile size, tile format, royalties file permissions and conditions of use.

However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis col. 10, lines 24-29 and 50-51; and col. 11, lines 8-10). The Examiner argued therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner and Davis. The Examiner argued that one would have been motivated to provide file information to inform user specific details which can enhance user's knowledge and inform them conditions.

The Applicant notes that claim 13 has been cancelled with this amendment rendering moot the Examiner's argument against this claim.

Komar in view of Kitsukawa, Ma and Gayraud

The Examiner rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, Ma and Gayraud et al. (U.S. Patent No. 5,436,637), hereinafter referred to as "Gayraud".

Regarding claim 20, the Examiner argued that Komar discloses a system comprising: maintaining a searchable digital image database wherein said digital image database contains at least one data item (citing Komar page 3, paragraph [0024]; the Examiner argued that here a database is disclosed in which a 3d digital image can be retrieved). The Examiner argued that therefore it would have been obvious and is of the ordinary capability of one skilled in the art to provide a searchable database for digital images; at least one iconette associated with a data

item of said at least one data item wherein said at least one iconette contains information relevant to said data item (citing Komar page 4, paragraph [0031]; the Examiner argued that once selected, the information about the item is available therefore an icon or iconette is associated with the item) and wherein said information relevant to said at least one data item comprises detailed information about said at least one digital image only (citing page 2, paragraph [0019]; page 3, paragraph [0023]). The Examiner argued that in addition to being able to provide information about the product within the image it also can provide display area format data which deals with the actual image itself such as the bitmap information. The Examiner argued that disclosed is the functionality to display both sources of information and one or the other as deemed for the selected area.

The Examiner argued that a display module for displaying a compacted view of said data item in a location of a display screen proximate to said at least one iconette, and wherein a selection of said at least one iconette invokes a display of information relevant to said data item and wherein said data item is displayed simultaneously with said display of said information relevant to said data item (citing page 3, paragraph [0025]; page 2, paragraphs [0016] and [0020]; page 4, paragraph [0031]).

The Examiner admitted that however Komar does not explicitly disclose a compacted view and that said compacted view of said data item is a compacted representation of said data item. The Examiner argued that however Kitsukawa discloses a method for providing on demand electronic advertising and further discloses a compacted view of an image (citing FIG. 5, col. 8, lines 57-67). The Examiner stated that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a compacted view of the image in Komar as taught by Kitsukawa. The Examiner argued that one would have been motivated to have the compacted view with focus set on item only.

The Examiner admitted that Komar also does not explicitly disclose wherein said display module displays data associated with said data item as a graphical icon on said display screen.

The Examiner argued that Gayraud discloses a graphical user interface system and methods for improved user feedback and further discloses hints of icons containing text or graphical messages of what an icon represents (citing col. 3, lines 45-59). The Examiner argued that therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include hints of data about what the icon represented in Komar as taught by Gayraud. The Examiner argued that one would have been motivated to have hints about the icon to improve the user-friendly aspect of the application because it allows the user to view where the icon will guide the user.

The Examiner further admitted that Komar does not explicitly disclose a user searches through the database. The Examiner argues that Ma discloses an image database that allows a user to search for a particular image. The Examiner Argues therefore it would have been obvious to make the database in Komar a user searchable database as taught by Ma and that one would have been motivated to allow the user to search the database because it would provide a direct and efficient query for known items of interest to the user.

The Applicant notes that claim 20 has been cancelled with this amendment rendering moot the Examiner's argument against this claim.

Komar in view of Kitsukawa, Ma, Gayraud, Willner and Davis

The Examiner rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Komar, Kitsukawa, Ma and Gayraud as applied in claim 20 and further in view of Willner and Davis.

Regarding claim 21, the Examiner argued that Komar, Kitsukawa, Ma and Gayraud disclose a method and system as in claim 20 above and further discloses a selection module for selecting said at least one iconette to invoke said display of

information relevant to said data item (citing Komar, page 2, paragraph [0016]). However, the Examiner admitted that Komar, Kitsukawa, Ma and Gayraud do not explicitly disclose wherein said object of information includes copyrights at least one of the following; file size, file format, royalties file permissions and conditions of use. However, the Examiner argued that Willner discloses a method and device for image surfing and discloses providing additional information about image including file size (citing Willner col. 8, lines 24-31). The Examiner argued that Davis discloses associating image metadata with an image which includes copyright information and format (citing Davis col. 10, lines 24-29 and 50-51; col. 11, lines 8-10). The Examiner argued that it would have been obvious to one having ordinary skill in the art at the time of the invention to provide file information as relevant information in the modified Komar as taught by Willner and Davis. the Examiner argued one would have been motivated to provide file information to inform the user of specific details which can enhance the user's knowledge and inform them of conditions.

The Applicant notes that claim 21 has been cancelled with this amendment rendering moot the Examiner's argument against this claim.

III. Newly Presented Claims

The Applicant notes that claims 22-41 have been newly presented with this amendment. The limitations for these newly presented claims is disclosed primarily in paragraphs [0037] - [0043], [0046] and FIGS. 4-5 of the Applicant's specification.

The Applicant submits that the Examiner's presented prior art references do not disclose these limitations of claim 22-41.

The Applicant's invention is a system and method of searching for, displaying and accessing information about digital images. The Applicant has narrowed the claims to be directed to a *user searchable digital image database* and displaying the search results in the form of *thumbnail images*. One of the Applicant's innovations claimed is that an iconette is located within the *frame* around the thumbnail of the image. Selection of the iconette within the frame displays the information about the digital image. This is disclosed in the Applicant's paragraph [0037]. Komar in view of Kitsukawa and further in view of Ma does not disclose this limitation.

The Examiner has argued that Komar discloses that the relevant information displayed is detailed information of the digital image. Komar does not, in fact, disclose relevant information *displayed* which comprises detailed information about the *digital image*. This is shown in the Examiner's citation as Komar discloses utilizing *display area format data* 117. The Examiner has argued that this display area format data is displayed to the user; however, this is not disclosed as being *displayed* to the user in the Komar reference. The Examiner has not addressed this fact in the previous office action arguments. Format data utilized by the system and not displayed (or even disclosed with the capability of being displayed) can not be considered to be detailed information *displayed*.

The Examiner has further argued that "anyone of ordinary skill in the art would be *easily* capable of providing display information". Is the Examiner now arguing that U.S.C. §103 includes the *ease of modification or production* instead of

obviousness of innovation? The Applicant submits the Examiner's argument is moot as U.S.C. §103 refers to whether an invention is obvious or not. The Examiner must provide factual evidence of this obviousness. The ease or difficulty of modifying the prior art is not in the patent statutes. The Examiner's argument does not refer to factual obviousness. The Examiner has merely stated that one of ordinary skill in the art (a computer programmer) could program a computer. The Examiner continues with the argument that if one *could* modify the prior art, the Applicant's invention is therefore obvious. As all innovation in every field is a modification of prior art innovation, a *prima facie* case of obviousness cannot be that if one can easily modify the prior art it is therefore obvious. Some of the greatest innovations in history are simple and easy modifications to the prior art; the *innovation* aspect of the invention being the patentable subject matter.

The Applicant further notes that claims 22, 29 and 36 include the limitation of a "thumbnail" image. A thumbnail image is the *entire* image in a reduced-sized form. The Examiner has defined "compact" as "smaller" and has referenced Kitsukawa items 517 and 527. Item 527 is not a compact view or a thumbnail view of item 517, however. The Examiner has somehow determined that a *small* view of only a *portion* of a larger view is still the entire larger view; i.e., a compact view. "Compact", by definition, is the *entire* item or view compacted into a smaller area or size and not just small, as submitted by the Examiner. Therefore, Kitsukawa item 527 is not a compacted or thumbnail view of item 517.

The Applicant further notes that claims 22, 29 and 36 include the limitation wherein a plurality of iconettes are *embedded* within a frame. This is also not disclosed in the prior art. The Examiner has argued that Komar and Kitsukawa disclose a frame, but has not argued that iconettes are disclosed embedded within this frame.

Claims 23, 30 and 37 include the limitation wherein the information relevant to the digital image is displayed in a form of a graphical pop-up window by rolling a graphically displayed cursor over the iconette. Claims 24, 31 and 38 include the

limitation wherein an iconette information window comprising an interactive region for initiating a transaction is displayed by clicking an iconette. Claims 26, 33 and 40 include the limitation wherein each iconette represents a different function. Claim 29 further narrows the Applicant's claims to include the limitation wherein the iconettes are color-coded. These limitations are not disclosed in the Examiner's cited prior art references.

Therefore, to anticipate or show obviousness of the Applicant's independent claims the prior art must disclose all of the following: 1) a user searchable digital image database; 2) a thumbnail image representing a digital image within a frame in response to a search; 3) embedding within the frame a plurality of iconettes; 4) wherein the iconettes represent a plurality of user selectable functions associated with the digital image; and 5) selection of the iconette displays information relevant to the digital image.

Based on the foregoing, the Applicant respectfully requests allowance of the newly presented claims 22-41.

IV. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited. A Request for Continued Examination (RCE) under 37 CFR 1.114 is also submitted herewith, including the RCE fee of \$810.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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